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In re Application of:
JENKINS, Martin, et al.
U.S. Application No.: 10/573,443
PCT No.: PCT/EP2003/050662
International Filing Date: 26 September 2003
Priority Date: None
Attorney's Docket No.: 016782-0355
For: CATALYTIC CONVERTER AND
METHOD FOR MAKING SAME

DECISION

This decision is issued in response to the "Reply To Notification Of Defective Response" filed 22 March 2007, treated herein as a petition under 37 CFR 1.181 to confirm that the declaration filed during the international phase is acceptable under 37 CFR 1.497. No petition fee is required.

BACKGROUND

On 26 September 2003, applicants filed international application PCT/EP2003/050662. The international application did not claim an earlier priority date, and it designated the United States. On 07 April 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for filing the basic national fee was thirty months from the international filing date, i.e., 26 March 2006.

Subsequent to the filing of the international application, applicant filed an executed Declaration of Inventorship under PCT Rule 4.17(iv) (hereinafter the "Rule 4.17(iv) declaration"). The declaration was filed within the time period permitted under PCT Rule 26ter. The Rule 4.17(iv) declaration did not comply with the instructions for such declarations in that the PCT application number was not indicated in the body of the declaration.

On 24 March 2006, applicants filed a Transmittal Letter seeking entry into the U.S. national stage accompanied by, among other materials, payment of the basic national fee.

On 13 September 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that a proper oath or declaration, and the surcharge for filing the oath or declaration later than thirty months after the priority date, were required. The Notification indicated that the current oath or declaration (i.e., the Rule 4.17(iv) declaration) did not identify the application to which it was directed.

On 13 November 2006, applicants filed a response to the Notification Of Missing Requirements that included payment of the \$130 surcharge and a copy of the executed Rule 4.17(iv) declaration filed during the international stage of the application.

On 22 February 2007, the DO/EO/US mailed a Notification Of Defective Response (Form PCT/DO/EO/916) indicating that the response was defective in that applicant had resubmitted the same declaration.

On 22 March 2007, applicants filed the submission considered herein as a petition under 37 CFR 1.181. The petition argues that the Rule 4.17(iv) declaration filed during the international phase complies with the requirements of 37 CFR 1.497 and should therefore be accepted.

DISCUSSION

As discussed above, the Rule 4.17(iv) declaration was filed during the international phase of this application within the time limits provided for in PCT Rule 26ter. The issue here is whether the declaration properly “[i]dentifies the specification to which it is directed,” as required under 37 CFR 1.497(a)(2).

The instructions for PCT Rule 4.17(iv) declarations state that where, as here, such a declaration is filed after the filing of the original international application, the declaration must identify the international application to which it is directed by listing the PCT application number within the body of the declaration. Here, the Rule 4.17(iv) declaration filed by applicants does not comply with these instructions in that the declaration does not include the PCT application number within the body of the declaration. Regardless, applicants argue that the Rule 4.17(iv) declaration adequately identifies the specification to which it was directed; applicants rely on the fact that the declaration bears the attorney docket number that was listed on the Request (Form PCT/RO/101) filed to initiate the international application.

MPEP section 602(VI) sets forth the various forms of information that are considered adequate to identify the specification to which a declaration is directed. Applicants assert that this section of the MPEP “indicates that an attorney docket number is adequate identification.” However, the relevant MPEP provision refers specifically to the “attorney docket number which was on the **specification** as filed” (emphasis added). The MPEP does not state that the presence on the declaration of an attorney docket number contained on application materials other than the specification is an adequate identification of the specification to which the declaration is directed. A review of the specification as filed in the present international application confirms that there is no attorney docket number listed thereon. Based on the above, the presence on the Rule 4.17(iv) declaration of an attorney docket number that was listed on the Request form, but not on the specification as filed, is not an adequate identification of the specification to which the declaration was directed under the terms of the MPEP, nor does the present declaration contain any of the alternative forms of identifying information listed in MPEP section 602(VI). Accordingly, the Rule 4.17(iv) declaration filed here does not adequately identify the specification to which it is directed; the declaration therefore fails to comply with 37 CFR 1.497(a)(2).

Applicants also argue that 37 CFR 1.497(a) applies “only when a declaration under PCT Rule 4.17(iv) has not been submitted in the international application.” However, 37 CFR 1.497(a) expressly states that an acceptable oath or declaration is required if “a declaration **in compliance with this section** has not been previously submitted in the international application under PCT Rule 4.17(iv)” (emphasis added). As noted above, the Rule 4.17(iv) declaration filed here is not “in compliance with” 37 CFR 1.497 in that it fails to adequately identify the specification to which it is directed, as required under 37 CFR 1.497(a)(2). Thus, based on the express terms of 37 CFR 1.497(a), the previous submission of the non-compliant Rule 4.17(iv) declaration does not eliminate the requirement that applicants submit a proper declaration acceptable under 37 CFR 1.497(a)-(b).¹

Finally, applicants rely on MPEP section 1893.01(e) for the proposition that “a PCT Rule 4.17(iv) declaration takes the place of a declaration under 37 CFR 1.497(a)-(b).” However, as discussed above, and as expressly stated in 37 CFR 1.497(a) (which is set forth in full in MPEP section 1893.01(e)), the Rule 4.17(iv) declaration takes the place of a declaration filed under 37 CFR 1.497 only if the Rule 4.17(iv) declaration is “in compliance with” 37 CFR 1.497. Because the Rule 4.17(iv) declaration filed here is not in compliance with 37 CFR 1.497, such declaration cannot take the place of the oath or declaration required under 37 CFR 1.497(a)-(b).

CONCLUSION

Applicants’ petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

The Rule 4.17(iv) declaration submitted herein is not acceptable under 37 CFR 1.497 based on the failure to properly identify the specification to which the declaration was directed.

The present application is **ABANDONED** for failure to file a proper response to the Notification Of Defective Response (Form PCT/DO/EO/916) mailed 22 February 2007.

This application is being forwarded to the National Stage Processing Branch of the Office Of PCT Operations for further processing in accordance with this decision, including the mailing of a Notification Of Abandonment (Form PCT/DO/EO/909).



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¹ It is noted that the publication by the International Bureau of the international application with an indication that a Rule 4.17(iv) declaration was filed therein does not indicate that such declaration was in compliance with 37 CFR 1.497, as the International Bureau does not review such submissions for compliance with U.S. regulations.